

Appl. No. : 09/991,721
Filed : November 13, 2001

REMARKS

A. Disposition of Claims

Claims 1-13, 15, 17, 18, 25, and 27 are pending in this application. Two sets of claims were before the Patent Office. One set of claims remains.

B. A First Set of Claims

A first set of claims, 1-13, 15, 17, 18, 25, and 27, is directed to "a tumor cell." Upon further consideration, the Office holds that such a claim directed to a "tumor cell" cannot be reasonably interpreted as encompassing a human even if the cell might be located in vivo. Therefore the claim does not include nonstatutory subject matter. In view of this it is not necessary to recite that the claim "does not encompass said mammal". Thus the phrase has been excised from the claim. Similarly, a typographical error has been corrected in the claim that neither expands nor contracts the scope of protection.

C. A Second Set of Claims

A second set of claims, 28-44, directed to a vaccinia virus in an environment of use, has been rejected on the basis that the environment of use is not entitled to patentable weight. Claims 28-44 have been canceled without prejudice. The auxiliary set of claims was for negotiation purposes only and thus cancellation thereof is for reasons unrelated to patentability.

D. Support for the Amendment

Support for the amendment is found throughout the specification, for example, paragraph 0008. No new matter has been added. We acknowledge that Claim 25 is allowed. Reexamination and reconsideration of the application, as amended, are respectfully requested.

E. Compliance with 35 USC 112, first paragraph

The Patent Office rejected Claims 1-13, 15, 17, 18 and 27-44 under 35 USC 112, first paragraph, as failing to comply with the written description requirements. Claims 1 and 28 contained a typographical error of reciting a "tyrosine kinase", when a "thymidine kinase" is supported by the specification. Claim 1 has been amended to correct this typographical error and Claim 28 has been canceled. The rejection is thus rendered moot.

F. Compliance with 35 USC 102(b)

Claims 28-39, 41 and 42 were rejected by the Office under 35 USC 102(b), as being anticipated by Bodemer et al. (EP 0 443 335) and Paoletti et al. (WO 92/15672). 35 USC 102(b) states:

Appl. No. : 09/991,721
Filed : November 13, 2001

“A person shall be entitled to a patent unless-

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.”

Claims 28-44 have been canceled. The rejection is thus rendered moot.

G. Compliance with 35 USC 103(a)

Claims 28-42, including 12 and 13 [*sic*, 39 and 40], were rejected by the office under 35 USC 103(a) as being unpatentable over Bodemer *et al.* as evidenced by Kaplan (1989) and Buller *et al.* (1988), in further view of any one of Lee *et al.*, Kamb, Herlyn *et al.*, Rotter *et al.* or Spitsberg *et al.* 35 USC 103(a) states:

“A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

Claims 28-44 have been canceled. The rejection is thus rendered moot.

Appl. No. : 09/991,721
Filed : November 13, 2001

CONCLUSION

In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of all outstanding rejections are respectfully requested. Allowance of the claims at an early date is solicited. If any points remain that can be resolved by telephone, the Examiner is invited to contact the undersigned at the below-given telephone number.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 2/23/05

By: 

Nancy W. Vensko
Registration No. 36,298
Attorney of Record
Customer No. 45,311
(805) 547-5585

O:\DOCS\EB\EBI-1734.DOC
021605